REMARKS

Claims 1-12, 14 and 16-28 are pending. By this Amendment, no claims are cancelled, no claims are amended and no new claims are added.

Interview Summary

Applicant and applicant's attorney thank the Examiner for her time and courtesy during the telephonic interview on November 28, 2006. The merits of the § 112 first paragraph rejection in the office action dated September 27, 2006 were discussed. Applicant's attorney indicated that the drawings substantiate the claim language "the first optical axis is substantially laterally displaced from and substantially parallel to the second optical axis." The Examiner requested a citation to the MPEP or to case law supporting the assertion that the drawings can be used to support the claim language. Applicant's attorney and the Examiner agreed that Applicant would file a formal response making such a citation. This issue is addressed below under the heading 35 U.S.C. § 112.

35 U.S.C. § 112

The Office Action rejected claims 1-12 and 14 under 35 U.S.C. § 112, first paragraph. Specifically, the rejection indicates that the recitation "the first optical axis is substantially laterally displaced from and substantially parallel to the second optical axis" is not supported in the specification. Applicant respectfully traverses the rejection. The recited relationship is clearly depicted in Fig. 1 of the application as originally filed.

The Court of Appeals for the Federal Circuit has held, in *Vas-Cath Inc. v. Mahurkar*, that the requirements of the first paragraph of 35 U.S.C. § 112 can be met by reference to the drawings. 19 USPQ 2d 1111, 1118 (Fed.Cir. 1991). In *Vas-Cath*, the Federal Circuit indicated "the issue here is whether there is supporting disclosure and it does not seem under established procedure of long standing, approved by this Court, to be of any legal significance whether the disclosure is found in the specification or in the drawings, so long as it is there." See also MPEP

2163(II)(A)(3)(a), 2164 and 2164.01. Thus, Applicant respectfully submits that one of ordinary skill in the art would know how to make and use the invention without undue experimentation by reference to the written description and the drawings together. Applicant respectfully requests that the Examiner withdraw the rejection.

35 U.S.C § 103(a)

The Office Action rejected claims 1, 4-12, 16 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Tanijiri. The Office Action further states "Roberts first and second optical axis aren't substantially parallel, Roberts can still incorporate the both optics into a HMD (compact) and the optics still provide a clear image, meets the claims function and thus works equally as well. Thus, Applicant's limitation lacks criticality in the invention." Applicant respectfully traverses the rejection. The Office Action admits that the cited prior art references do not disclose or suggest that the first and second optical axes are substantially parallel. Thus, the references cited do not disclose or suggest all of the limitations recited in claim 1.

With regard to the rejection indicating that the limitation "lacks criticality" in the invention. The Board of Patent Appeals and Interferences has addressed the question of "lack of criticality." *Ex parte Michael J. Erland*, Appeal No. 1998-2864, slip op. In that case, the Examiner had rejected a claim limitation stating that it "lacks criticality." Id. at 13. The Board wrote that "we will not sustain the rejection of the claims under 35 U.S.C. §103(a) because the Examiner may not dismiss an explicit claim limitation by stating that it "lacks criticality." Id. The Board further stated "in any event, lack of criticality is not a measure of the obviousness of the claim subject matter." Id. at 14. Thus, "lack of criticality" does not support a rejection for obviousness under §103(a).

The Board again addressed a rejection for "lack of criticality" in *ex parte* Roger Massey. Appeal No. 2003-1660, slip op. at 6. The Board stated "It is not enough to merely allege that something is 'well known,' is an 'obvious matter of design choice,' or 'lacks criticality.'" The Board then cited *In re Lee*, which indicates "The factual inquiry whether to combine the references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions and cannot be dispensed with." 277 F.3d 1338, 1343, 61 USPQ 2d 1430, 1433 (Fed. Cir. 2002). Applicant respectfully requests that the Examiner withdraw the rejection.

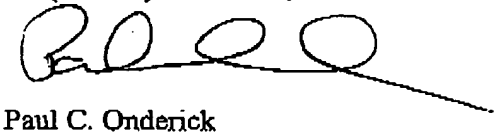
The Office Action further rejected claims 1-3, 14, 16-18 and 28 under 35 U.S.C. §103(a) as being unpatentable over Popovich in view of Tanijiri. Again the Office Action admits "Popovich first and second optical axis are not substantially parallel" and indicates "Roberts can still incorporate the both optics into a HMD and the optics still provide a clear image, meets the claim limitation and thus works equally well, thus Applicant's limitation lacks criticality in the invention." Again, as discussed above, "lack of criticality" is not a measure of obviousness under §103(a). Therefore the rejection is improper and Applicant respectfully requests that the Examiner withdraw the rejection.

Thus, independent claims 1 and 16 are patentable over the prior art of record. Claims 2-12 and 14 depend from claim 1 and are patentable for at least the same reasons as indicated above for claim 1. Claims 17-28 depend from claim 16 and are patentable for at least the same reasons as claim 16 discussed above. Applicant respectfully requests that the Examiner withdraw the rejection.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Paul C. Onderick
Registration No. 45,354

Customer No. 24113
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5766